CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Trademarks, 2900 Crystal Drive Arlington, Virginia 22202-3514 on the date shown below:

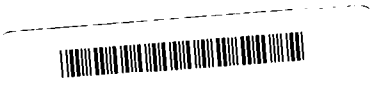
Agnes T. Buhyoff

Signature

Date: September 26, 2003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Applicant:	Peabodys Coffee, Inc.
Serial No.:	78/107053
Mark:	BLACK RHINO COFFEE
Classes:	30, 35 and 43
Filed:	February 5, 2002



09-29-2003

U.S. Patent & TMOfc/TM Mail Rcpt Dt. #39

To: Commissioner of Patents and Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514

REQUEST TO SUSPEND APPEAL AND REMAND FILE TO EXAMINING ATTORNEY FOR CONSIDERATION OF NEW EVIDENCE

I. Introduction

Applicant Peabodys Coffee, Inc. ("Applicant") respectfully requests the Trademark Trial and Appeal Board ("TTAB") to suspend the appeal in this matter and remand the file to the Examining Attorney for consideration of new evidence. This request is made pursuant to 37 CFR §2.142(d) and TBMP §1207.02. *See also In re Juleigh Jeans Sportswear, Inc.*, 24 USPQ2d 1694, 1696 (TTAB 1992); *In re Wells Fargo & Co.*, 231 USPQ 95, 101 n.24 (TTAB 1986).

2. The New Evidence in Question

The new evidence in question is a Trademark Coexistence Agreement entered into between Applicant and the Black Rhino Foundation (the "Foundation"), the owner of trademark registration (U.S. Regis. No. 2,217,877) for THE BLACK RHINO COOKIE COMPANY, on the basis of which the Examining Attorney has refused registration of Applicant's mark BLACK RHINO COFFEE under Trademark Act Section 2(d) of the Act, 15 U.S.C. §1052(d). In the Trademark Coexistence Agreement, the Foundation, among other things, has consented to Applicant's use and registration of BLACK RHINO COFFEE in respect of each the goods and services identified in Application Serial No. 78/107053 ("Applicant's Application") for registration of BLACK RHINO COFFEE. A true and correct copy of the subject Trademark Coexistence Agreement is attached hereto as Exhibit B. [*see*, Declaration of Gregory F. Buhyoff ("Buhyoff Declaration"), attached hereto as Exhibit A, ¶ 6]

II. Argument

1. *Applicant's Request Is Timely*

A request under 37 CFR §2.142(d) to suspend an appeal and remand the file for consideration of additional evidence must be filed prior to the rendering of the Board's final decision on appeal. *In re Johanna Farms, Inc.*, 223 USPQ 459, 460 (TTAB 1984); *In re Carvel Corp.*, 223 USPQ 65, 66 (TTAB 1984). Applicant's Appeal Brief was filed only very recently, and the TTAB has yet to issue a final decision on appeal. Accordingly, Applicant's request to suspend and remand is timely.

2. *Applicant's Request is for "Good Cause"*

In addition, a request to suspend and remand must include a showing of good cause therefor, and be accompanied by the additional evidence sought to be introduced. *See*, In *re Big Wrangler Steak House, Inc.* 230 USPQ 634, 635 n.4 (TTAB 1986); *In re Bercut Vandervoort & Co.*, 229 USPQ 763, 766 n.6 (TTAB 1986).

"Good cause" may be shown where the evidence was not previously available. *In re Zanova, Inc.*, 59 USPQ2d 1300, 1302 (TTAB 2001) In this case, Applicant began negotiating the Trademark Coexistence Agreement in April 2003 [*see*, Buhyoff Declaration, ¶ 3], but the parties were unable conclude the Trademark Coexistence Agreement until August 31, 2003, after the deadline for responding to the Final Refusal of the Examining Attorney. [*see*, Buhyoff Declaration, ¶ 4] In this regard, TBMP §1207.02 (citing *In re N.A.D., Inc.* 754 F.2d 996, 224 USPQ 969, 970 (Fed. Circ. 1985), and *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973)) states:

> "In addition, because a consent agreement offered in response to a refusal to register under Section 2(d) of the Act, 15 U.S.C. §1052(d) is inherently difficult and time-consuming to obtain, and may be highly persuasive of registrability, the Board will grant a request to suspend and remand for consideration of a consent agreement if the request, accompanied by the consent agreement, is filed at any time prior to the rendering of the Board's final decision on the appeal."

The Trademark Coexistence Agreement, a true and correct copy of which accompanies this request to remand is, in fact, a "consent agreement" in that, among other things, the Foundation has consented to Applicant's use and registration of BLACK RHINO COFFEE in respect of all the goods and services identified in Applicant's Application. This request to suspend and remand has been submitted before the TTAB

has rendered a final decision on appeal. Based on the foregoing, Applicant has shown "good cause" for remanding the file to the Examining Attorney for consideration of the Trademark Coexistence Agreement.

3. The New Evidence is Not "Cumulative"

It should be further noted that this new evidence is not "cumulative." The Trademark Coexistence Agreement is the first and only evidence to date which shows: (i) that the Foundation also knows of no case of actual confusion to date (despite the fact that the marks have coexisted on the market since April 2002), (ii) that the Foundation has consented to Applicant's use registration of BLACK RHINO COFFEE for the goods and services identified in Applicant's Application, (iii) that both parties believe that use of their respective marks has not and will not cause consumer confusion, and (iv) that the parties have agreed to take steps to correct any instance of confusion that may arise.

4. The New Evidence Should Be Entitled to "Great Weight"

In *In re N.A.D., Inc.*, 754 F.2d 996, 224 USPQ 969 (Fed. Cir. 1985), the Federal Circuit made it clear that consent to register agreements should be accorded significant weight in determining the issue of likelihood of confusion. In *Bongrain International (American) Corp v. Delice de France, Inc.*, 811 F.2d 1479, 1484-85, 1 USPQ2d 1775 (Fed.Cir. 1987), the Federal Circuit stated that the parties who entered into the agreement:

> "are in a much better position to know the real life situation than bureaucrats or judges and therefore such agreements may, depending on the circumstances, carry great weight...."

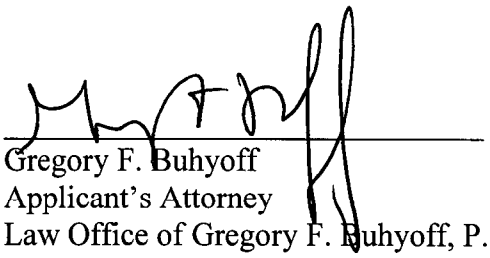
Applicant submits that where, as here, (i) the owner of the cited registration has consented to Applicant's use and registration of BLACK RHINO COFFEE for the goods

and services identified in Applicant's Application, (ii) the parties have acknowledged that there have been no known instances of actual confusion between their respective marks, (iii) the parties believe that use of their respective marks has not and will not cause consumer confusion, and (iv) the parties have agreed to take steps, as necessary to correct any instance of confusion that may arise, the Trademark Coexistence Agreement is highly relevant and, under the circumstances, should be considered and accorded "great weight".

III. CONCLUSION

For the foregoing reasons, Applicant respectfully requests the TTAB to suspend the appeal and remand the file to the Examining Attorney for consideration of the Trademark Coexistence Agreement entered into between Applicant and the Black Rhino Foundation.

Respectfully submitted,



Gregory F. Buhyoff
Applicant's Attorney
Law Office of Gregory F. Buhyoff, P.C.
1635 Village Center Circle, Suite 140
Las Vegas, NV 89134-6375

Date: September 26, 2003

GFB:bms
attachment

DECLARATION OF GREGORY F. BUHYOFF IN SUPPORT OF REQUEST TO SUSPEND APPEAL AND REMAND FILE TO THE EXAMINING ATTORNEY FOR CONSIDERATION OF NEW EVIDENCE

I, Gregory F. Buhyoff, declare that:

1. I am an attorney admitted to practice law in the States of California and Nevada, and am the Attorney of Record for Peabodys Coffee, Inc. ("Applicant"), the Applicant in the subject matter. I have personal knowledge of the facts set forth in this Declaration and if called as a witness could and would testify competently thereto.

2. Applicant's application for registration of BLACK RHINO COFFEE, Application Serial No. 78/107053 ("Applicant's Application"), was the subject of a January 27, 2003 final refusal ("Final Refusal") based on a prior registration of THE BLACK RHINO COOKIE COMPANY owned by the Black Rhino Foundation (the "Foundation"), an Illinois non-profit corporation.

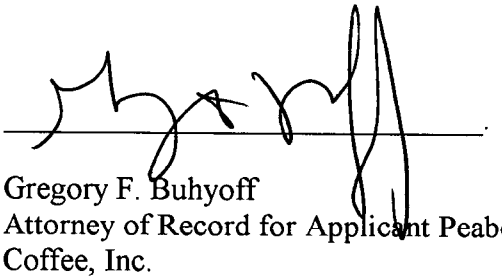
3. In April 2003, Applicant and the Foundation entered into discussions aimed at concluding a Trademark Coexistence Agreement concerning the parties' respective trademarks.

4. It took until the beginning of August for Applicant and the Foundation to reach agreement as to the terms of a Trademark Coexistence Agreement, and until on or about August 31, 2003 for the parties to fully execute the same. For this reason, it was not possible for Applicant to submit the executed Trademark Coexistence Agreement to the Examining Attorney by the July 27, 2003 deadline for responding to the Final Refusal.

5. Applicant submits that the foregoing constitutes "good cause" for why the Trademark Coexistence Agreement should be considered as new evidence on the issue of "likelihood of confusion" between Applicant's BLACK RHINO COFFEE mark and the Foundation's THE BLACK RHINO COOKIE COMPANY mark, and therefore an appropriate basis for the Trademark Trial and Appeal Board to grant Applicant's request that the pending appeal of the Final Refusal be suspended and the case remanded with instructions that the Examiner reconsider Applicant's Application in light of the terms and provisions of the Trademark Coexistence Agreement.

6. A true and correct copy of the fully executed Trademark Coexistence Agreement between Applicant and the Foundation is attached herewith as Exhibit B.

Dated this 26th day of September, 2003.



Gregory F. Buhyoff
Attorney of Record for Applicant Peabodys Coffee, Inc.

TRADEMARK COEXISTENCE AGREEMENT

This Trademark Coexistence Agreement ("Agreement") is entered into by and between, the Black Rhino Foundation, Inc., an Illinois non-profit corporation having its principal offices located at 1250 Cherry Street, Winnetka, Illinois 60093 ("BRF") and Peabodys Coffee, Inc., a Nevada corporation having its principal offices at 3845 Atherton Road, Suite 9, Rocklin, California 95765 ("Peabodys").

WHEREAS, BRF has owned a federal trademark registration for THE BLACK RHINO COOKIE COMPANY (Reg.No. 2,217,877) for "cookies and bakery items" since 1999, and has been using said trademark in U.S. commerce in respect of such items since at least 1996;

WHEREAS (i) Peabodys has been using the trademark BLACK RHINO COFFEE in U.S. commerce since approximately April 2002, (ii) Peabodys has a pending intent-to-use federal trademark application for the word mark BLACK RHINO COFFEE (Ser.No. 78,107,053) in respect of the goods and services identified in the attached printout from the U.S. Patent and Trademark Office database, and (iii) Peabodys has filed, or is planning to file one or more additional U.S. federal trademark applications for trademarks that contain the word mark BLACK RHINO COFFEE as an element thereof;

WHEREAS, BRF and Peabodys acknowledge that their respective trademarks have peaceably coexisted in the U.S. market since approximately April 2002 without any known instances of actual confusion among members of the consuming public; and

WHEREAS, BRF and Peabodys believe that concurrent use of their respective current trademarks in commerce has not and will not cause confusion among the consuming public;

NOW, THEREFORE, for good and valuable consideration, the receipt of which is hereby acknowledged, BRF and Peabodys agree as follows:

1. BRF hereby consents to Peabodys' continuing use of the trademark BLACK RHINO COFFEE, and any existing and future marks containing BLACK RHINO COFFEE as an element thereof, provided that such use is limited to the goods and services identified in Peabodys' pending federal trademark application for BLACK RHINO COFFEE. BRF also consents to Peabodys obtaining a federal trademark registration for the word mark BLACK RHINO COFFEE and other marks containing BLACK RHINO COFFEE as an element thereof, provided that such registrations are limited to the goods and services identified in Peabodys' pending federal trademark application for BLACK RHINO COFFEE. BRF agrees not to oppose, cancel, contest or otherwise dispute, directly or indirectly, through any action, proceeding or otherwise, in any court, tribunal or other forum, Peabodys' right to use any of the trademarks referred to herein, or any applications or registrations in respect thereof.

2. In the event either party becomes aware of any consumer mistake, misidentification or confusion as to source, sponsorship or affiliation as between the BRF and Peabodys or their respective goods and/or services, that party shall promptly notify the other party and, after consultation with the other party, take whatever steps are reasonably necessary or prudent to correct the mistake, misidentification or confusion.

3. If either party believes that any third party is infringing any of the marks that are the subject of this Agreement, that party shall give notice to the other party to this Agreement, and the parties shall reasonably cooperate in attempting to prevent infringement of their respective marks and in confirming the positions and agreements set forth in this Agreement. This provision shall not, however, be construed to require either party to bring or join any legal proceeding in order to fulfill this duty of cooperation.

4. This Agreement shall be binding upon and inure to the benefit of the parties hereto and their respective successors, transferees, licensees and assigns, whether by merger, sale, consolidation, license or otherwise, including all successors in interest and licensees of any of BRF's and/or Peabodys' trademarks.

5. This Agreement represents the entire understanding of the parties. Any modification of this Agreement shall be void unless made in writing and duly signed by or on behalf of each of the parties.

6. This Agreement may be executed in counterparts, with each such counterpart deemed to be an original instrument.

7. Any notice required or permitted by this Agreement shall be sent by fax and U.S. mail to:

A. If to the Black Rhino Foundation, Inc.:
1250 Cherry Street
Winnetka, Illinois 60093
Fax: _____
Attention: _____

B. If to Peabodys Coffee, Inc.:

3845 Atherton Road, Suite 9
Rocklin, CA 95765
Fax: (916) 632-6099
Attention: Todd Tkachuk

WHEREFORE, the parties have made this Agreement effective on the latter of the two dates set forth below.

BLACK RHINO FOUNDATION, INC.

By: Maggie Heydt

Name: Maggie Heydt

Title President

Date: 8/31/03

PEABODYS COFFEE, INC.

By: _____

Name: Todd Tkachuk

Title: President / CEO

Date: 8/20/03

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Electronic Search System (TESS)

TESS was last updated on Fri Sep 19 04:28:21 EDT 2003

Check Status ***(TARR contains current status, correspondence address and attorney of record for this mark. Use the "Back" button of the Internet Browser to return to TESS)***

Typed Drawing

Word Mark	**BLACK RHINO COFFEE**
Goods and Services	IC 030. US 046. G & S: ground and whole bean coffee, herbal and non-herbal teas; coffee, tea, non-alcoholic beverages made with a base of coffee and/or espresso; ready-to-drink non-alcoholic coffee beverages IC 043. US 100 101. G & S: restaurant, coffee house and cafe services; catering services IC 035. US 100 101 102. G & S: wholesale distributorships, retail outlets and mail order services featuring ground and whole bean coffee; tea; non-alcoholic coffee and espresso beverages and non-alcoholic beverages made with a base of coffee and/or espresso
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	78107053
Filing Date	February 5, 2002
Filed ITU	FILED AS ITU
Owner	(APPLICANT) PEABODYS COFFEE, INC. CORPORATION NEVADA 3845 Atherton Road Suite 9 Rocklin CALIFORNIA 95765
Attorney of Record	Gregory F. Buhyoff
Disclaimer	NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "COFFEE" APART FROM THE MARK AS SHOWN
Type of	

Mark	TRADEMARK. SERVICE MARK
Register	PRINCIPAL
Live/Dead Indicator	LIVE

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Trademarks, 2900 Crystal Drive Arlington, Virginia 22202-3514 on the date shown below:

Agnes T. Buhyoff

Signature

Date: September 26, 2003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Applicant:	Peabodys Coffee, Inc.
Serial No.:	78/107053
Mark:	BLACK RHINO COFFEE
Classes:	30, 35 and 43
Filed:	February 5, 2002

09-29-2003

U.S. Patent & TMOfc/TM Mail Rcpt Dt. #39

To: Commissioner of Patents and Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514

APPLICANT'S APPEAL BRIEF

I. INTRODUCTION

Pursuant to the Notice of Appeal that was timely filed, Applicant respectfully appeals the Examining Attorney's January 27, 2003 final refusal ("Final Refusal") to allow registration of Applicant's mark BLACK RHINO COFFEE based on Trademark Act §2(d), 15 U.S.C. §1052 (d). For the following reasons, Applicant submits that it was error for the Examining Attorney to conclude that Applicant's mark BLACK RHINO COFFEE so resembles the registered trademark THE BLACK RHINO COOKIE COMPANY (U.S. Regis. No. 2,217,877) as to be likely to cause confusion, or to cause

mistake, or to deceive. U.S. Regis No. 2,217,877 is owned by the Black Rhino Foundation, Inc. (the "Foundation"), an Illinois non-profit corporation whose stated mission is to save the black rhinoceros and other rhinoceros species from extinction (*see*, Exhibit A to Applicant's Response and Amendment to Office Action (hereinafter referred to as "Response and Amendment") dated December 4, 2002 on file herein.

Applicant notes here that Applicant is also filing a Request to Suspend Appeal and Remand for consideration of new evidence which for good cause could not have been submitted before the July 27, 2003 deadline for responding to the Examiner Attorney's Final Refusal.

II. ARGUMENT

1. Law Applicable to Issue of "Likelihood of Confusion"

The Examining Attorney correctly cited *In Re E.I. du Pont de Nemours & Co.*, 476 F.2d, 1357; 177 USPQ 563 (CCPA 1973) as the authority listing the factors to be considered in determining whether there is a likelihood of confusion between two trademarks. (The usefulness of the *Du Pont* factors was reaffirmed in *The Toro Company v. ToroHead, Inc.*, 61 USPT2d 1164 (TTAB 2001).)

(i) The Similarity or Dissimilarity of the Marks in Their Entireties as to Appearance, Sound, Connotation and Commercial

Both marks, THE BLACK RHINO COOKIE COMPANY and BLACK RHINO COFFEE, contain the words "black" and "rhino". However, it is well-settled that, in evaluating whether two marks are similar or dissimilar, the marks must be considered in their entireties, taking into account their appearance, sound, connotation and commercial impression. *Estate of P.D. Beckwith, Inc. v. Commissioner of Patents*, 252 U.S. 538, 545-546; *In re National Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed.

Circ. 1985). Applicant submits that manufacturers do not normally use different trademark formats. For example, the maker of LEROUX liquors would not normally sell one item as LEROUX apricot liqueur and another item as THE LEROUX COMPANY peppermint schnapps. Manufacturers strive for trademark consistency, and this extends to trademark formats (e.g., capitalization, punctuation, use of qualifying words such as "The" and "Company") even more than to other elements (e.g., color and placement). At an intuitive level, consumers know this, and perceive inconsistency in trademark formats as signaling different brands. Thus, consumers encountering LEROUX apply brandy and THE LEROUX COMPANY artichoke hearts in the same supermarket would assume these products came from different companies far more readily than if the artichoke hearts were sold under the trademark LEROUX without the added words THE and COMPANY. Simply stated, though the presence or absence of the words THE and COMPANY might not appear significant relative to the more distinctive portion of the two marks in questions here, *i.e.*, the words BLACK RHINO, the two additional words in fact significantly alter the commercial impression made by the Foundation's mark, making confusion unlikely.

(ii) The Similarity or Dissimilarity and Nature of the Goods or Services as Described in an Application or Registration, or in Connection with Which a Prior Mark is in Use

As the record shows, the registration for THE BLACK RHINO COOKIE COMPANY is limited to "cookies and bakery goods." To Applicant's knowledge, this mark is only being used for cookies that are sold exclusively by mail order (*see*, Declaration of Todd Tkachuk, attached to Response and Amendment as Exhibit B, ¶ 2) Applicant's application for BLACK RHINO COFFEE, meanwhile, primarily covers the

sale and distribution of ground and whole bean coffee, teas and coffee-based beverages, as well as restaurant, coffee house and café services. In the Office Actions below, the Examining Attorney noted that "the goods and services travel in the same channels of trade because registrant's goods could be sold or baked by the Applicant's restaurant or catering services." Though true in the abstract, it is *not true* in the context of the marketplace for the parties' respective goods and services.

Apart from the different channels through which the parties sell their products, it must be emphasized that the Foundation does not just sell cookies, but *cookies with a message and a purpose.* An apt analogy is the well-known mark GIRL SCOUT COOKIES (*see*, Exhibit C to Response and Amendment). Like the Foundation's mark THE BLACK RHINO COOKIE COMPANY, GIRL SCOUT COOKIES was registered in International Class 30 for cookies, without qualification as to the fact that the cookies are sold solely in connection with the Girl Scout organization's eleemosynary purposes. Yet, despite the lack of any qualification in the GIRL SCOUT COOKIES trademark registration, no consumer would expect to find GIRL SCOUT COOKIES products sold in the supermarket, alongside similar products from commercial manufacturers. This is because GIRL SCOUT COOKIES, as a brand, does not stand for just cookies, but for cookies with a message and a purpose.

In this case, the same is true. There is never a time that the Foundation's products are offered outside of the context of its eleemosynary purpose, namely, to promote the welfare of the endangered black rhinoceros. The fact that Applicant's products are not offered with this message and purpose immediately distinguishes its brand in the eyes of consumers. This impression is further enhanced by the fact that the products of

Applicant and those of the Foundation are sold through completely different distribution channels (*see*, discussion at II. 1 (iii) below), and the fact that Foundation's use of the mark THE BLACK RHINO COOKIE COMPANY is descriptive. Though the mark does not describe the Foundation's cookies, it describes the purpose for which the cookies are being sold. Applicant's use of the mark BLACK RHINO COFFEE, on the other hand, is arbitrary in the manner of arbitrary brands such as CAMEL cigarettes. Consequently, when the parties' respective businesses are considered, it can be seen that consumers must readily distinguish between the Foundation's descriptive use of its marks and Applicant's arbitrary use of its mark, making confusion unlikely.

Further, relevant evidence shows that in the precise facts of this case, consumers in fact do not confuse marks identifying different brands in the fields of cookies and coffee. Exhibit D to Response and Amendment shows current use of the mark HONOLULU COOKIE COMPANY for cookies. This mark co-exists in the marketplace with the mark HONOLULU COFFEE CO. for coffee, as shown in Exhibit E to Response and Amendment. The same is true for PACIFIC COOKIE COMPANY for cookies (*see*, Exhibit F to Response and Amendment) and PACIFIC COFFEE COMPANY for coffee (*see*, Exhibit G to Response and Amendment)

An even closer analogy to the facts of this case is presented by the co-existence in the marketplace of the marks BYRD COOKIE COMPANY for cookies (see, Exhibit H to Response and Amendment) and SONG BIRD for coffee (see, Exhibit I to Response and Amendment). As the printouts of the websites in said Exhibits H and I show, the mark BYRD COOKIE COMPANY is used by a traditional, for-profit manufacturer, while the mark SONG BIRD is used by an eleemosynary association to sell coffee promoting "the

health and safety of bird populations." The only difference between the co-existence of these marks in the marketplace and the co-existence of the marks presented in this case is that, in this case, the eleemosynary association sells cookies and the for-profit concern sells coffee, whereas in the other case, the eleemosynary association sells coffee and the for-profit concern sells cookies.

The foregoing shows that consumers do not confuse marks containing a dominant portion plus the descriptive words COOKIE COMPANY for cookies with other marks consisting of the same dominant portion for coffee. Taken together with (i) the parties' substantially different businesses, --cookies sold to promote the welfare of the black rhinoceros, and coffee sold for ordinary commercial purposes, (ii) their completely different sales channels, and the other factors addressed herein, consumers are unlikely to confuse BLACK RHINO COFFEE and THE BLACK RHINO COOKIE COMPANY.

(iii) The Similarity or Dissimilarity of Established, Likely-to-Continue Trade Channels

To the best of Applicant's knowledge, THE BLACK RHINO COOKIE COMPANY cookies are sold exclusively by mail order, and have been sold exclusively through this sales channel since the inception of the brand. (*see*, Exhibit B to Response and Amendment, ¶ 2) On the other hand, BLACK RHINO COFFEE products are primarily sold in grocery stores, coffee houses, branded kiosks and similar sales outlets. (see, Exhibit B to Response and Amendment, ¶ 5) There is no evidence that the Foundation intends to broaden or diversity its sales channels beyond mail order sales. Based on the foregoing, the dissimilarity of the parties' trade channels would also militate against a likelihood of confusion.

(iv) The Conditions Under Which, And Buyers to Whom Sales are Made, i.e., "Impulse vs. Careful, Sophisticated Purchasing

It is reasonable to assume that purchasers of cookies that are sold exclusively by mail in order to raise funds to save an endangered species are careful, thoughtful consumers whose act of purchase is a deliberate, considered act, rather than the "impulse" of someone at a grocery store or supermarket. Similarly, purchasers of Applicant's upscale specialty coffee tend to be thoughtful and deliberate. This factor should also militate against confusion.

(v) The Fame of the Prior Mark (Sales, Advertising, Length of Use)

Applicant is unaware of any facts indicating that THE BLACK RHINO COOKIE COMPANY could in any way be considered a famous mark. Indeed, the mark appears to be little known. An April 21, 2001 press release from the Foundation says that the organization raised about $180,000 between 1995 and 2001. (*see*, Exhibit L to Response and Amendment) Thus, even if all of the Foundation's revenue came from the sale of cookies, sales of the cookies would be far too small to create fame for the mark (contrast this, for example, with annual sales of $1.3 billion of products under the TORO mark, which the TTAB found to be famous.)

(vi) The Number and Nature of Similar Marks in Use on Similar Goods

Among the large number of marks listed on the U.S. Patent and Trademark Office's database that consist of the word "Rhino" in whole or in part, Applicant has found several instances in which RHINO marks of various types have been registered and/or are being used in connection with different food products. (*see*, Exhibit M to Response and Amendment) The existence of these marks has a weakening effect on the RHINO component of THE BLACK RHINO COOKIE COMPANY mark, thus making

marks which contain this element, but also contain other different components, easily distinguishable.

(vii) The Nature and Extent of Any Actual Confusion

Applicant announced the BLACK RHINO COFFEE brand to the market in a series of prominent press releases that were picked by a number of industry, business and general media organs beginning in April 2002 (*see*, Exhibit B to Response and Amendment, ¶ 3; Exhibit N to Response and Amendment) These announcements, as well as Applicant's website have coexisted with the Foundation's website continuously since April 2002. (*see*, Exhibit B to Response and Amendment, ¶ 4) BLACK RHINO COFFEE products are being sold in substantial volumes in grocery store chains and other retail outlets in the Southeastern, Mid-Atlantic and Midwest regions of the U.S., as well as throughout California. (*see*, Exhibit B to Response and Amendment, ¶ 5) Notwithstanding, Applicant has not received a single communication from any consumer, wholesale or retail sales outlet, or any other market participant (including the Foundation) claiming or suggesting any instance of actual confusion between THE BLACK RHINO COOKIE COMPANY and BLACK RHINO COFFEE marks. (*see*, Exhibit B to Response and Amendment, ¶ 6) Based on the foregoing, this factor also favors Applicant.

(viii) The Length of Time and Conditions Under Which There Has Been Concurrent Use Without Evidence of Actual Confusion

Applicant announced the BLACK RHINO COFFEE brand in April 2002, and has been actively promoting the brand since that time. (*see*, Exhibit B to Response and Amendment, ¶ 3)

Substantial volumes of coffee were shipped to major grocery chains in the Southeast, Mid-Atlantic and Midwest regions of the U.S., as a consequence of which BLACK RHINO COFFEE products are now being sold in over 400 supermarkets through the country, in addition to being sold at the Applicant's sell-established sales outlets throughout California. (*see*, Exhibit B to Response and Amendment, ¶ 5) Although BLACK RHINO COFFEE products have been on the market for a relatively short period of time, the extent to which they have been promoted and sold without evidence of any actual confusion also shows that confusion is unlikely.

(ix) The Variety of Goods on Which the Mark is Used

To Applicant's knowledge, cookies are the only goods on which THE BLACK RHINO COOKIE COMPANY mark has ever been used. (*see*, Exhibit B to Response and Amendment, ¶ 2; Exhibit O to Response and Amendment) Indeed, it would be unclear how this mark could be used for much else. Notably, the Foundation has not sought registration of a more generalized mark, such as BLACK RHINO, that would suggest a broader family of products. This factor also favors Applicant.

(x) The Market Interface Between Applicant and the Owner of the Prior Mark

This factor was not an issue on the record that was before the Examining Attorney, though, as noted above, Applicant will be requesting the TTAB to suspend this appeal and remand the case to the Examining Attorney for consideration of new evidence in the form of a Trademark Coexistence Agreement that was recently concluded between Applicant and the Foundation.

(xi) The Extent to Which Applicant Has a Right to Exclude Others from Use of its Mark on its Goods

To Applicant's knowledge, there is no limitation on its right to exclude others from using its mark on its goods. Accordingly, this factor also favors Applicant.

(xii) The Extent of Potential Confusion, *i.e.*, Whether *De Minimis* or Substantial

Because of the care and thoughtfulness of consumers purchasing both the Foundation's and Applicant's products (in the former case, because they are supporting a cause and, in the latter case, because the goods are upscale), the extent of potential confusion is slight, and therefore the resolution of this factor favors Applicant.

(xiii) Another Other Established Fact Probative of the Effect of Use

The Foundation's primary, if not sole market presence is on the World Wide Web. Though it is impractical for Applicant to demonstrate this in a written response to an Office Action or on appeal, the traditional "bricks and mortar" character of Applicant's sales outlets and channels, make it unlikely that consumers would ever perceive the two marks as related.

(xvi) Summary of *Du Pont* Factors

All of the factors markedly favor Applicant, except the similarity of the marks. However, even on this issue, the differing formats used by the parties for their marks distinguish them in an important way (*viz.*, commercial impression), making this factor virtually neutral. To the extent there is any "potential" overlap in likely-to-continue trade channels, the eleemosynary and esoteric context in which the Foundation's goods are offered—solely in connection with its website on animal preservation issues—makes it unlikely any such overlap would cause consumers to be confused into thinking the marks were in any way related. For all of these reasons, Applicant respectfully submits that the

du Pont factors, viewed in light of all of the relevant evidence, favor registration of Applicant's mark BLACK RHINO COFFEE.

III. CONCLUSION

For all of the foregoing reasons, Applicant prays that the Examining Attorney's refusal to allow registration of Applicant's BLACK RHINO COFFEE mark be reversed, and that this mark be allowed for registration in Classes 30, 35 and 43.

Respectfully submitted,

Gregory F. Buhyoff
Applicant's Attorney
Law Office of Gregory F. Buhyoff, P.C.
1635 Village Center Circle, Suite 140
Las Vegas, NV 89134-6375

Date: September 26, 2003

GFB:bms
attachment